

## REMARKS

The Applicant appreciates the Examiner's recommendation that a patent attorney be secured. The Applicant has elected to take that action.

Any references to the specification in this response will be made to U.S. Patent Application Publication 2002/0160184 A1 in accordance with the Examiner's instructions.

### **35 U.S.C. § 112 Rejection**

Claims 1-7 were properly rejected by the Examiner as failing to follow the format required by the Patent Office under 35 U.S.C. § 112. Claims 1-7 have been cancelled and new claims 8-12 are provided herein. Claims 8-14 provide similar subject matter, but are in the format normally presented to the Patent Office.

### **Obviousness Rejections**

Claims 1-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Forman et al., U.S. Patent No. 5,712,012. The Forman et al. reference shows an adaptable disposable placemat formed of a sheet of cellulosic material having top and bottom planar surfaces with a peripheral edge. Adhesive is located on the bottom surfaces for affixing onto a dining surface. Placemats are described as easily removed from the dining surfaces. Furthermore, they are described as having an optionally included water-resistant coating for preventing soiling or fluid penetration during use. Finally, the placemats are described as being packagable in stacks or rolls for convenience. The stacked configuration of placemats is illustrated in Figure 3. A rolled configuration of placemats is shown in Figure 4.

Kaminstein in U.S. Patent No. 4,457,964 is referenced by the Examiner for the teaching that "it is conventional to use coating compositions which prevent coated placemats from sticking together when stacked on top of one another." Citing Col. 7, lines 29-31.

New claims 8-14 provide limitations which are not anticipated or obvious in light of Forman et al. and/or Kaminstein.

Specifically, claim 8 provides that the placemat is initially provided in a packaged configuration wherein the top planar surface of the sheet is folded to provide a first and second section. In this packaged configuration, the first and second sections are parallel to one another and contact one another. Support for this limitation may be found in the specification as originally filed. (See Paragraph No. 21 on page 2 of the published patent application No. US2002/0160184 A1.) In the right column, lines 9-11 of the published application, the Applicant states that: “this placement is uniquely folded in such a way that the operative surface (Front Side Fig.1.) is not contaminated by outside elements until opened.” In the prior art, placemats “are exposed to elements so that they are contaminated before even used.” The cited prior art of both Forman et al. and Kaminstein embody this perceived deficiency. Specifically, the prior art placemats must be handled on their top surfaces to remove a first placemat from an adjacent placemat thereby potentially contaminating at least one of the first placemat or the adjacent placemat.

Accordingly, new claim 8 is believed to be distinguishable from the prior art cited and is believed to now be allowable. Such action is respectfully requested. Additionally, claims 9-13 depend from claim 8 and are believed to be allowable since claim 8 is believed to be allowable.

Claim 9 provides the limitation that the peripheral edge has at least four sides. This claim stands or falls with claim 8.

Claim 10 provides another limitation not found in the cited prior art. Specifically, the sheet is claimed to be folded into eight panels with each of the eight panels contacting at least one of the other eight panels along the top surface so that each of the eight panels are initially

provided in a sanitary manner when in the packaged configuration. This claim is very similar to the originally provided claim 2 except including the contacting top surface portions limitation of claim 8 and provided in proper format under 35 U.S.C. § 112. This is not simply a “geometric arrangement,” but a way to put the top surfaces of the sections in contact with one another to provide a sanitary packaged configuration in the preferred embodiment. The placemats of the cited prior art are not folded with the top surface portions contacting one another as described so there would be no need or suggestion in the cited prior art for this limitation. Accordingly, claim 10 is believed to be specifically allowable.

Claim 11 is somewhat similar to originally provided claim 3. The spacing of the adhesive is believed to be advantageous since it relates to advantageously providing the placemat in the packaged configuration while performing the dual function of adhering the placemat to the eating surface in a deployed and in use configuration. Since the prior art placemats are not provided in a folded package configuration, there is no need for the specialized arrangement of an adhesive as is claimed in claim 11.

Claim 12 is very similar to originally filed claim 5. Claim 12 stands or falls with new claim 8.

Claims 13 and 14 are very similar to originally filed claim 7. The tabs are claimed to assist in transitioning the placemat from the packaged to the deployed configuration. There is no need for tabs in the prior art since these placemats are not provided in an initial packaged configuration with a top planar surface folded into sections which contact one another for at least sanitary purposes. Accordingly, these claims are believed to be separately allowable based on this limitation as well.

## Conclusion

As explained above, new claims 8-14 are believed to be allowable. Although six new claims have been added including one independent claim, the original independent claim along with its dependent claims have been canceled. Accordingly, no additional fees are believed to be due at this time. It is respectfully submitted that new claims 8-14 are in proper position for allowance and such action is respectfully requested.

Respectfully submitted,

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on this 13<sup>th</sup> day of August, 2003.

By: 

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